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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,932	11/26/2003	Dieter Horstmann	10537/276	9642
26646	7590	08/08/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			BLAKE, CAROLYN T	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/722,932	HORSTMANN ET AL.	
	Examiner	Art Unit	
	Carolyn T. Blake	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 13-15 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on May 12, 2005.
2. The objection to the drawings is withdrawn in view of the amendment.
3. The objection to claim 8 is withdrawn in view of the amendment.
4. The text of those sections in Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

5. Claims 1, 3-5, 7-9, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott (3,728,919).

Regarding claim 1, Scott discloses a tool for at least one of cutting and noncutting treatment of a metallic component, comprising: a shank-shaped section (13) including a tool section subject to wear and a cavity (27), an arrangement (20) configured to admit a pressure medium to the cavity to monitor operability of the tool; and a monitoring device (24, 26) configured to generate a signal in accordance with a pressure change in the pressure medium wherein the shank-shaped section includes a predetermined breaking point (diameter change in FIG 2).

Regarding claim 3, Scott discloses the cavity (27) includes a blind bore in the shank-shaped section (13).

Regarding claim 4, Scott discloses the tool is configured as an interchangeable unit, the arrangement configured to admit the pressure medium including an arrangement configured to admit compressed air to the cavity (27) by connecting lines.

Regarding claim 5, Scott discloses the monitoring device includes a pressure switch (26) configured to react at a preset value of a pressure change.

Regarding claim 7, Scott discloses the breaking point is configured as a local reduction in diameter at the tool section.

Regarding claim 8, Scott discloses the tool section is configured as a blanking punch (13), the tool section including a cutting edge and a predetermined breaking point reduced in diameter relative to the shank-shaped section.

Regarding claim 9, Scott discloses the tool section includes a mandrel (15) configured to shape a metal sheet.

Regarding claim 13, Scott discloses a tool for at least one of cutting and noncutting treatment of a metallic component, comprising: a shank-shaped section (13) including a tool section subject to wear and a cavity (27); means (pressure source 20) for admitting a pressure medium to the cavity for monitoring operability of the tool; and monitoring means (24, 26) for generating a signal in accordance with a pressure change in the pressure medium, wherein the shank-shaped section includes a predetermined breaking point (diameter change in FIG 2).

Regarding claims 14 and 15, Scott discloses an arrangement configured to perform a method that includes admitting compressed air to a blind bore (27) in the tool; generating a signal if a preset value of a pressure change of the compressed air is exceeded in accordance with a fracture of the tool; and monitoring a function of the tool in accordance with the pressure change. See col. 2, lines 14-22.

Claim Rejections - 35 USC § 103

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott in view of Applicant's Admitted Prior Art (hereafter, AAPA). Scott fails to disclose the work piece is a cast metallic component. In the last Office action, Official notice was taken it is old and well known to cut metallic components that are cast. Most metals can be cast and it is cost effective for certain manufacturing quantities because some machining operations can be eliminated. Applicant failed to traverse the merits of this assertion, so the common knowledge is taken to be admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cast metallic work piece, as disclosed by AAPA, with the Scott device for the purpose of cost savings.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott as applied to claim 7 above, and further in view of Johnson (5,960,812). Scott fails to disclose the local reduction in diameter includes a ring-like notch. However, Johnson discloses a tool (10) comprising a shank-shaped section (12) including a tool section subject to wear and a cavity wherein the shank-shaped section (12) includes a predetermined breaking point in the form of a ring-like notch (24). The notch breaking point concentrates the strain at a specific location, controlling the specific location the tool with break. Therefore, it would have been obvious to one of ordinary skill in the art at provide the Scott tool with a ring-like notch, as disclosed by Johnson, in order to control the break location.

Response to Arguments

8. Applicant's arguments filed May 12, 2005 have been fully considered but they are not persuasive.

9. Regarding Applicant's argument the Scott reference does not anticipate Claim 1, FIG 2 of the reference should be carefully examined. One of ordinary skill in the art would be able to determine the tool would break at the decreased diameter section because this is where strain is the greatest. The fact Scott does not specifically refer to a "predetermined breaking point" is immaterial. Furthermore, a breaking point in the form of a "ring-like notch" is well known in the art, as evidenced by the Johnson reference.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leitner (3,628,366) discloses a ring-like notch predetermined breaking point.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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August 1, 2005



Allan N. Shoap
Supervisory Patent Examiner
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